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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/432,338	11/02/1999	KLAUS ZIMMERMANN	10191/1157	9914
26646	7590	04/21/2004	EXAMINER	
KENYON & KENYON ONE BROADWAY NEW YORK, NY 10004			KEASEL, ERIC S	
			ART UNIT	PAPER NUMBER
			3754	
DATE MAILED: 04/21/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/432,338

Applicant(s)

ZIMMERMANN ET AL.

Examiner

Eric Keasel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-90 is/are pending in the application.
- 4a) Of the above claim(s) 8-82 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 83-90 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Group III in the paper filed 2 Feb 2004 is acknowledged.
2. Claims 8-82 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected inventions, there being no allowable generic or linking claim.

Election was made **without** traverse in the paper filed 2 Feb 2004.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 83-90 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Newly added independent claims 83 and 88 include recitations "defining" (or "to define") "a duration of the time window so that the current flowing through the consumer during the time window does not exceed a threshold value". Claims 83 and 88 also recite "reducing" (or "to reduce") "the duration of the time window if the current is greater than the threshold value." The originally filed application does not disclose the "defining" step (or an arrangement to define); the originally filed application discloses a "determining" step that includes an iterative loop that

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includes reducing the duration of the time window if the current is greater than the threshold value. So, the newly added claims include new matter in one or two ways. One, the originally filed application does not support “defining” (or “to define”). Second, if “defining” is meant to be “determining”, then the originally filed application does not support the defining/determining step (or arrangement) to be separate from the reducing step (or arrangement).

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 83-90 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Newly added independent claims 83 and 88 include recitations “defining” (or “to define”) “a duration of the time window so that the current flowing through the consumer during the time window does not exceed a threshold value”. Claims 83 and 88 also recite “reducing” (or “to reduce”) “the duration of the time window if the current is greater than the threshold value.” The originally filed application does not disclose the “defining” step (or an arrangement to define); however, the originally filed application discloses a “determining” step that includes an iterative loop that includes reducing the duration of the time window if the current is greater than the threshold value. Since, the specification sets forth a “determining” step, which does not appear to be synonymous with (or encompass) the claimed “defining” step, it is unclear what the metes and bounds of the claims are. If applicant intended the disclosed “determining” step to be synonymous with (or encompass) the claimed “defining” step, it is also vague and indefinite as

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to how the defining/determining step (or arrangement) can be separate from the reducing step (or arrangement), when the defining/determining step (or arrangement) encompasses the reducing step (or arrangement).

In claim 86, line 2, "the period of time" lacks antecedent basis in the claims. It is vague and indefinite as to whether this is related to the "time window", "the duration of the time window", or some other parameter.

7. In light of the above informalities, the claims have been examined as could best be understood by the examiner. The examiner's failure to apply prior art to any of the claims should not be construed as an indication of allowable subject matter.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 83-90 (as understood) are rejected under 35 U.S.C. 102(b) as being anticipated by Rehbichler (US Patent Number 5,592,921).

Rehbichler discloses the method and the corresponding apparatus of activating a solenoid valve for controlling metering of fuel into an internal combustion engine. The switching instant is determined by analyzing the variation over time of the current (see column 2, lines 5-10 and column 3, lines 41-44). The current is determined throughout the time window including the time "immediately before" the end of the time window. The duration of the time window varies

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in relation with the current such that the time window is reduced (i.e. the switching means is opened) when current exceeds a threshold value and is increased when the current is below the threshold value (see column 4, lines 12-24).

10. Claims 83-90 (as understood) are rejected under 35 U.S.C. 102(b) as being anticipated by Fischer et al. (GB 2311559 A).

Fischer et al. disclose the method and the corresponding apparatus of activating a solenoid valve for controlling metering of fuel into an internal combustion engine. The switching instant is determined by analyzing the variation over time of the current (see page 2, lines 1-5). The current is determined throughout the time window including the time “immediately before” the end of the time window. The duration of the time window varies in relation with the current such that the time window is reduced when current exceeds a threshold value and is increased when the current is below the threshold value (see page 1, lines 18-21, page 6, lines 8-12).

Response to Arguments

11. Applicant's arguments filed 2 Sep 2003 have been fully considered but they are not persuasive.

Applicant appears to be reading the limitation “any rise in current in the electromagnetic consumer does not disconnect an output stage of the electromagnetic consumer” from the specification into the term “threshold value”. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric Keasel whose telephone number is (703) 308-6260. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Mancene can be reached on (703) 308-2696. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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